REMARKS

Upon entry of this amendment, claims 1-3, 5-17 and 19–22 are pending. Claims 1, 3, 5-8, 10, 12-17 and 19 have been amended; claim 18 has been cancelled; and new claims 21 and 22 have been added. Reconsideration of the rejections and objections is respectfully requested in view of the foregoing amendment and these remarks.

In the office action mailed February 1, 2005, the examiner:

- rejected claim 18 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;

- rejected claims 3-4 under 35 U.S.C. § 112, second paragraph, as being indefinite;

- rejected claims 1-3, 5 and 8-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,430,624 to Jamtgaard ("the Jamtgaard patent") in view of U.S. Provisional Application No. 60/179,330 to Huang ("the Huang provisional");

- rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over the Jamtgaard patent in view of the Huang provisional and further in view of U.S. Patent No. 6,687,873 to Ballantyne ("the Ballantyne patent");

- rejected claim 6 under 35 U.S.C. § 103(a) as being unpatentable over the Jamtgaard patent in view of the Huang provisional and further in view of U.S. Patent No. 6,560,621 to Barile ("the Barile patent");

- rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over the Jamtgaard patent in view of the Huang provisional and further in view of U.S. Patent No. 5,557,722 to DeRose ("the DeRose patent"); and

- rejected claims 19 and 20 under 35 U.S.C. § 103(a) as being unpatentable over by the Jamtgaard patent in view of the Ballantyne patent.

Rejections

35 U.S.C. § 101

Claim 18 stands rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the examiner stated that "the claimed invention is not tangibly embodied in

a computer readable/executable medium because a carrier wave does not constitute a tangible medium." Claim 18 has been cancelled, thus rendering this rejection moot.

35 U.S.C. § 112, Second Paragraph

Claims 3 and 4 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. In particular, claim 3 recites the limitation "contextual definitions" without sufficient antecedent basis in the claim. Claim 4 is rejected for incorporating this limitation via claim 3.

Claim 3 has been amended to recite "context data" in lieu of "contextual definitions," and is now consistent with the language of claim 1 from which it depends. Thus, applicant requests that the 35 U.S.C. § 112(2) rejections of claims 3 and 4 be withdrawn.

35 U.S.C. § 103(a)

Claims 1-3, 5 and 8-20
Claims 1-3, 5 and 8-18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the Jamtgaard patent in view of the Huang provisional, while claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the Jamtgaard patent in view of the Ballantyne patent.

Independent Claim 1 has been amended to recite, *inter alia*:

> "...registering with an operating system of a computer as a printer driver;
> receiving data in the form of a print stream from at least one
> application program running on the computer;
> dividing the data into text data, graphics data and context data;
> generating at least one first file for storing at least a portion of the text
> data, graphics data or context data ...."

Independent Claim 15 has been amended to recite, *inter alia*:

> "...communicating with an operating system of [a] server computer or
> user computer to register with the operating system as a printer
> driver;
> receiving data from at least one application program in the form of a
> print stream;
> dividing the data into text data, graphics data and context data; and,
> generating at least one file for storing at least a portion of the
> text data, and graphics data, or context data ...."

Independent Claim 16 has been amended to recite, *inter alia*:

"... communicating with an operating system of [a] server computer or
    user computer to register with the operating system as a printer driver;
    receiving data from at least one application program in the form of a
        print stream;
    dividing the data into text data, graphics data and context data; and,
    generating at least one file for storing at least a portion of the text data,
        graphics data, or context data ...."

Independent Claim 17 has been amended to recite, *inter alia*:

"... registering with an operating system as a printer driver ... receiving
    data from at least one application program in the form of a print stream
    ... dividing the data into text data, graphics data, and context data; and,
    ... generating at least one file for storing at least a portion of the text
data, graphics data, or context data ...."

Independent Claim 19 has been amended to recite, *inter alia*:

"A computer system comprising an operating system ... an application
program [and] ... an ... additional program manipulating at least one data
stream... wherein the at least one data stream comprises a print stream,
and the additional program is registered with the operating system as a
printer driver."

Claims 1, 15, 16, 17 and 19 are patentable over the Jamtgaard patent, the Huang
provisional and the Ballantyne patent because these references, taken alone or in combination,
fail to disclose, teach or suggest "...register[ing] with [an] operating system as a printer driver...,"
and "receiving data ... in the form of a print stream," as required by claims 1, 15, 16 and 17, or
"manipulating at least one data stream... wherein the at least one data stream comprises a print
stream, and the additional program is registered with the operating system as a printer driver..."
as required by claim 19. The examiner concedes that the Jamtgaard patent and Huang
provisional fail to disclose expressly receiving a print stream from an application program. (*See*
Detailed Action, pg. 9, lines 16-17).

In relation to the rejection of previously pending claim 4, as well as claims 19 and 20 the
examiner cites the Ballantyne patent as disclosing the concept of receiving a print stream of data.
(*see* Detailed Action, pg. 9, lines 17-18; pg. 12, lines 6-7). Ballantyne, however, fails to disclose
"... register[ing] with [an] operating system as a printer driver...," as required by claims 1, 15, 16,

17 and 19. Rather, the Ballantyne patent merely notes that data extraction from print streams is a recent improvement, (*see* the Ballantyne patent, col. 17, lines 54-62), but does not disclose any details of how such extraction might occur. Further, the Ballantyne patent refers to U.S. Patent No. 6,031,625 ("the Sherman patent") as disclosing such print steam data extraction. (*See* the Ballantyne patent, col. 17, lines 59-60). The Sherman patent, discloses a system for receiving reports and for extracting fields from printer code information, referred to as a print data stream, (*see* the Sherman patent, col. 1, lines 56-59), but it does not disclose that its system "register[s] with [an] operating system as a printer driver" as required by claims 1, 15, 16, 17 and 19. Rather, the Sherman patent discloses searching, examining, parsing and manipulating data located within print streams of different types and does not provide specifics of how the system links to an operating system or an application program. (*See* id., col. 3, lines 19-23; lines 45-57; col. 5, lines 25-32; col. 8, lines 6-10; col. 10, lines 65-66; col. 11, lines 43-45).

Thus, the cited references, whether considered individually or in combination, fail to disclose, teach or suggest all of the limitations of independent claims 1, 15, 16, 17 and 19. Applicant, therefore, request that the 35 U.S.C. § 103(a) rejections of these claims be withdrawn, and that the claims be allowed. With respect to claims 2, 3, 5 and 8-14, which depend from claim 1, and which recite additional features of the invention, applicant requests that the 35 U.S.C. § 103(a) of these claims be withdrawn for the same reasons as stated for claim 1.

Claim 4

Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the Jamtgaard patent in view of the Huang provisional and further in view of the Ballantyne patent. Claim 4 has been cancelled thus rendering this rejection moot.

Claim 6

Claim 6 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the Jamtgaard patent in view of the Huang provisional and further in view of the Barile patent. Claim 6 is properly patentable because the differences between the invention and the prior art of record are such that the subject matter claimed, as a whole, is not shown by the prior art to have been known or obvious. Specifically, there is no motivation combine the Barile patent with the Jamtgaard patent and the Huang provisional that might lead the person of ordinary skill in the art

to arrive at applicant's invention from the cited references. Applicant finds nothing in the Jamtgaard patent, the Huang provisional or the Barile patent that would provide a motivation for a selection and combination that might lead in the direction of the claimed invention. Such a motivation can only be found in the present application. The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the applicant's disclosure. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

In making the rejection of previously-pending claim 4, the examiner conceded that the Jamtgaard patent and the Huang provisional do not disclose expressly receiving a print stream from the application program. (*See* Detailed Action, p. 9, lines 16-17). And while the Barile patent discloses a print driver that accepts output from any application (*see* the Barile patent, col. 4, lines 58-60), it does so for the purpose of creating a web formatted file from the application file format. (*See id.*, col. 5, lines 6-9). This is just the opposite to the purpose and function of the Jamtgaard patent, which is used to take information *from* an Internet content provider's web site in various forms and then re-deliver it via a translation server to information appliances 15 in a format that is completely customized to the end user's device type. (*See* the Jamtgaard patent, col. 4, lines 58-66). The Huang provisional is directed to a system that generates structured documents with user-defined document type definitions using structure-based font information. (*See* the Huang provisional, p. 5, lines 1-3). An input module loads structured or non-structured documents to the system and can import the documents from one or more document database. (*See* id., pg. 5, lines 4-7). But the Huang provisional does not disclose how such importing would occur, nor is there any disclosure in the Huang provisional that would lead one of ordinary skill in the art, in view of the Barile patent, to accept input via a print stream or using the print driver of Barile. Again, such motivation can only be found in the present application. The distinguishing aspects of the invention are particularly and distinctly claimed, and there is no basis of record to conclude the invention claimed, as a whole, would have been obvious.

Thus, claim 6 is patentable because no prima facie case of obviousness can be made. *See* MPEP §2143 ("[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation ... to modify the reference or to combine reference teachings."); *see also In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper). The

teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the applicant's disclosure. *See In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Thus, for the reasons stated above, applicant requests that the 35 U.S.C. § 103(a) rejection of claim 6 be withdrawn, and that the claim be allowed.

Claim 7

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the Jamtgaard patent in view of the Huang provisional and further in view of the DeRose patent. Claim 7 depends indirectly from independent claim 1, and thus contains all of the limitations of the base claim. As stated above in relation to claim 1, the Jamtgaard patent, the Huang provisional and the Ballantyne patent, either alone or in combination, fail to disclose, teach or suggest "...register[ing] with [an] operating system as a printer driver...," and "receiving data ... in the form of a print stream," as required by claims 1, 15, 16 and 17, or "manipulating at least one data stream... wherein the at least one data stream comprises a print stream, and the additional program is registered with the operating system as a printer driver..." as required by claim 19. The DeRose patent does not remedy this deficiency. Rather discloses a system and method for generating a representation of an electronic document, (*see* the DeRose patent, Abstract), but does not discuss obtaining data from a print stream.

Thus, the cited references, whether considered individually or in combination, fail to disclose, teach or suggest all of the limitations of claim 7, and applicant, therefore, requests that the 35 U.S.C. § 103(a) rejection of this claim be withdrawn, and that the claim be allowed.
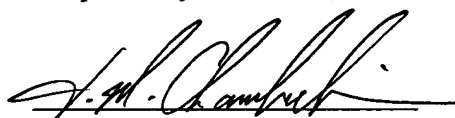
New Claims 21 and 22

New claims 21 and 22 depend from independent claim 1, and recite additional features of the invention. Thus, claims 21 and 22 are considered patentable for the same reasons as stated for independent claim 1.

In view of the foregoing amendment and remarks, it is respectfully submitted that claims 1-3, 5-17 and 19-22 are in condition for allowance. Prompt favorable action thereon is respectfully solicited.

No fee is believed to be due with due with this response. If any fees are required, please charge such required fees to deposit account **50-2061.**

Respectfully submitted,

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